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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,629	03/09/2006	Mauro Gelli	6672/PCT	7215
6858 7590 12/17/2009 BREINER & BREINER, L.L.C. P.O. BOX 320160 ALEXANDRIA, VA 22320-0160				
EXAMINER				
MUSSEY, BARBARA J				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
12/17/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/566,629

**Applicant(s)**

GELLI ET AL.

**Examiner**

BARBARA J. MUSSER

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/19/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44, 45, 51-62, 64 and 91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44, 45, 51-62, 64 and 91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/09 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 44, 45, 51-62, 64, and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biagiotti(WO 99/44814) in view of Ruppel et al.(U.S. Patent 5,339,730).

Biagiotti discloses forming an embossed laminate by making protuberances on a first web which form a background pattern, making second protuberances on the first web which have greater height and less density than the first pattern(Figure 7), applying glue to the second protuberances, and joining it to a second web.(Figure 6) Biagiotti discloses coloring can be applied by coloring the adhesive.(Pg. 5, ll. 30-31)The reference does not disclose application of any colored pattern to the first set of

protuberances. Ruppel et al. discloses embossing a pattern and then printing on the protuberances formed by embossing so that the ink pattern is on the interior of the laminate instead of coloring the adhesive since this allows more choice in the ink used(Col. 1, ll. 22-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to print on one of the sets of the protuberances since Ruppel discloses this would allow the ink pattern to be between the layers of the laminate and since this would allow more choice in the type of ink used.(Col. 1, ll. 22-33) While Ruppel et al. discloses the printing occurs on the web to which glue is not subsequently applied, it would have been obvious to apply the ink to the protuberances on either of the webs since there are only two choices as to the web to which the ink is applied so it would have been obvious to try either depending on which pattern was desired to have ink and since there is no suggestion in Ruppel et al. that the ink could not applied to the protuberances on the same web to which the glue is later applied.

Regarding claim 45, Biagiotti discloses a pressure roll(311) and an embossing roll(309) and the adhesive is applied to the embossments while the web is still on the embossing roll.(Figure 6)

Regarding claims 51, 56, and 91, Biagiotti discloses the background embossing has a density of 10-100 per square centimeter.(Pg. 15, ll. 27-28)

Regarding claims 52 and 57, one in the art would appreciate that the percent of the surface covered by background embossing is within the purview of one skilled in the art. Additionally, Figure 6A shows the embossing wheel and the embossments appear

to be spaced one embossment apart. Extrapolating this to all directions, the embossments would cover 1 in 9 spaces or less than 15%.

Regarding claims 53, 54, and 91, Ruppel et al. discloses it is known to color the glue.(Col. 1, ll. 22-25) It would have been obvious to one of ordinary skill in the art at the time the invention was made to color the glue and to make it a different color from the printed pattern since two colors form a more decorative and pleasing pattern than a monochromatic color scheme.

Regarding claim 58, Figure 7 of Biagiotti shows one of the second embossments per at least 6 of the first. Extrapolating that in each direction yields one of the second embossments per 36 of the first, leading to less than 3 of the second embossments per centimeter even for 100 per cm of the first.

Regarding claims 61, 62, and 64, one in the art would appreciate that the pattern for the printing could be any conventional type of pattern and would have been well within the purview of choice of one skilled in the art.

#### ***Response to Arguments***

4. Applicant's arguments filed 9/21/09 have been fully considered but they are not persuasive.

For response to the arguments on pages 6-13 of the after final, applicant is directed to the advisory action dated 10/13/09.

Regarding applicant's argument that applicant's method provides a colored pattern which appears to have a uniform color over the entire surface, examiner is confused. Is applicant stating that the entire surface of one of the webs is the same

color, as suggested by the statement that the material "appears to have a substantially uniform color on the entire surface thereof"? How then is this printing a design on it?

Regarding applicant's argument that Ruppel teaches a printed design which is identical to or complementary to that of the embossed pattern, so does applicant since the claims state the ink is applied to the embossed pattern.

Regarding applicant's argument that Ruppel is directed to avoiding using colored glue, Ruppel teaches colored glue is known. It is noted Ruppel is not the reference being modified so examiner does not have to explain why one is going against the teachings of the reference. While the reference does suggest reasons why it is not desirable, this does not mean that those in the art do not know how to do it, or that it would not have been obvious if the desired product was such that the problem were considered worth the final result.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA J. MUSSEY whose telephone number is (571)272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BJM  
/B. J. M./  
Examiner, Art Unit 1791

/Richard Crispino/  
Supervisory Patent Examiner, Art Unit 1791